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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/698,346 | 10/31/2003 | Kari Systs | 915-005,079 | 9664 |
| 4955 7590 12/08/2009 WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP BRADFORD GREEN, BUILDING 5 755 MAIN STREET, P O BOX 224 MONROE, CT 06468 | | | | |
| EXAMINER | | | | |
| WORJLOH, JALATIE | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3685 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 12/08/2009 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/698,346

Applicant(s)

SYSTA ET AL

Examiner

Jalatee Worjloh

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-8, 10, 11, 13-16, 18, 19, 21-26, 29, 31-41, 43 and 44 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 4-8, 10, 11, 13-16, 18, 19, 21-26, 29, 31-41, 43 and 44 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 5, 2009 has been entered.
2. Claims 1, 4-8, 10, 11, 13-16, 18, 19, 21-26, 29, 31-41, 43 and 44 are pending.

Response to Arguments

3. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-8, 10, 11, 13-16, 18, 19, 21-26, 29, 31-41, 43 and 44 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6226618 to Downs et al. ("Downs") in view of Tadayon et al. ("Tadayon").

Referring to claims 1, 5, 6, 10 and 40, Downs discloses verifying the integrity of information contained in a package for distribution by an electronic device, indicative of the conditions in which usage of the package is allowed (see col. 7, lines 18-24 -the digital content

of Downs is packaged into a secure container (SC), which allows for the verification of the authenticity and integrity of the digital content) and if the verification of the integrity of the package fails, prohibiting the distribution of the package, if said verifying does not fail, examining said information indicative of the conditions in which the usage of the package is allowed to determine whether the usage of the package is allowed and if said examining determines that usage of the package is allowed, distributing said package; wherein said the usage conditions and the media object are stored in different files (col. 19 table, steps 133-148 and col. 27, lines 10-21; col. 59 & 60 – “Usage Conditions Tool”). Also, the Clearinghouse in Downs verifies the usage condition that is stored in a secured container(see step 133-143 of col. 18 & 19; col. 27, lines 10-21; col. 59 & 60 – “Usage Conditions Tool”). Downs also discloses a package that contains at least media object (see col. 18 & 19 - Content SC). Additionally, Downs teaches the method wherein said conditions are protected by a digital signature (see col. 7, lines 18-22 - Downs utilizes SC for distribution of packages; the SC is a carrier of information that uses digital signature for protection); the method wherein said conditions comprising information about the cost of the package and the payment method (see claim 1 above & col. 24, lines 36-40- the license SC carries transaction information, which includes cost of the package and the payment method); the information/conditions comprise at least one of the following: date, time of day, identity of the electronic device, identity of the other electronic device, manufacturer of the electronic device, model or version of the electronic device, model or version of the other electronic device, manufacturer of the package, user subscription information and at least one other detail of the other electronic device (see col. 18 & 19 table - the license SC). Downs does not expressly disclose teach a single package including both the Content SC and the usage

condition and that the package includes information indicative of the conditions in which the distribution of the package is allowed. However, Tadayon teaches a package including both the media object and information indicative of the conditions in which the distribution of the package is allowed; if said examining determines that distribution of the package is allowed, distributing said package, wherein said package is distributed to another electronic device and wherein said information indicative of conditions in which the distribution of the package is allowed or is not allowed comprising at least one detail relating to at least of the other electronic device, wherein the electronic device communicating with the other device exchanges information on said at least one detail of the other device for determining whether the distribution is allowed or not (see abstract; fig. 2, item 200; fig. 3 and related text) and the media object and conditions are stored in different files (see claim 8). Both Downs and Tadayon teaches usage conditions/rights; however, Tadayon usage conditions include additional information relating to package distribution. Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself-that is in the substitution usage condition of Downs with that of Tadayon. Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

Referring to claims 4, Downs discloses storing the usage conditions and media object (see col. 18 and 19). Downs does not expressly disclose storing the usage conditions and object in the same file. However, Tadayon teaches wherein said information indicative of the conditions in which the distribution of the package is allowed and the at least one media object

are stored in the same file (see Fig. 2, item 200; claim 9 of Tadayon); At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method of Downs with that of Tadayon. One of ordinary skill in the art would have been motivated to do this because it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) and MPEP §2144.04 V.C).

Referring to claim 7, Downs discloses the method wherein a software is executed in the electronic device for controlling the handling of the package, and the modification of the package is prevented by said software (see col. 18 & 19 tables).

Downs in view of Tadayon discloses the method of claim 8 (see claim 1 above).

Claims 11 and 14-16, 18 teach a system that performs the steps of method claims 1, 3-11, 13-19 are rejected on the same rationale as claims 1, 4, 5, 8-10 above.

Claim 19 teaches an electronic device that performs the steps of method claim 1 above; therefore, this claim is rejected on the same rationale as claim 1 above.

Claims 22 and 23 teach an electronic device that performs the steps of method claims 4 and 5 above; therefore, these claims are rejected on the same rationale as claims 22 and 23 above.

Referring to claim 24, Downs teaches the device wherein the controller is configured for preventing modifying the package (see col. 18 and 19 table – the content is encrypted thereby preventing modifications).

Claim 29 is teaches a mobile device that performs the steps of claim 1 above; therefore, this claim is rejected on the same rationale as claim 1.

Claim 31 is a computer readable medium stored with machine executable instructions for performing steps of claim 1 above; therefore, this claim is rejected on the same rationale as claim

Claim 32 is a computer readable medium according to claim 31 that include instructions for performing the steps 8 above; therefore, this claim is rejected on the same rationale as claim 8

Claims 33, 34 and 37 rejected on the same rationale as claims 1 and 6 above.

Claim 35 is rejected on the same rationale as claim 4 above.

Claim 36 is rejected on the same rationale as claim 5 above.

Claim 41 is rejected on the same rationale as claim 1 above.

Claim 43 is rejected on the same rationale as claim 10 above.

Claim 44 is rejected on the same rationale as claim 1 above.

6. Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs and Tadayon as applied to claim 33 above, and further in view of U.S. Publication No. 2002/0069263 to Sears et al. ("Sears").

Downs and Tadayon discloses the method of claim 33. These references fail to teach the package is a Java archive or application descriptor. Sears teaches this feature (see paragraph [0036] - the page comprising a Java archive and application descriptor). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the package of Downs to include a Java archive or application descriptor. One of ordinary skill in the art would have been motivated to do this because it permits application manifest information and description to be stored in a database for subsequent indexing. Application descriptor information may be used by search engines looking for applications with particular name, provider, size, capabilities and/or functionality (see paragraph [0036]).

Conclusion

7. Although the conditional/optional elements have been considered, Applicant is reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See MPEP §2106 II. C: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]"

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and 571-273-6714 for Non-Official /Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3685

/Jalatee Worjloh/

Primary Examiner, Art Unit 3685